

OFFICIAL

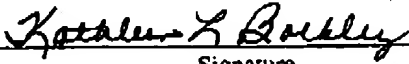
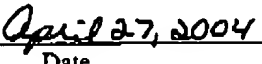
PATENT

**UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Ting Tina Ye et al. Confirmation No.: 2367  
Serial No.: 09/839,065 Examiner: M. DeSanto  
Filing Date: April 20, 2001 Group Art Unit: 3763  
Docket No.: 1001.1471101 Customer No.: 28075  
For: MICROCATHETER WITH IMPROVED DISTAL TIP AND TRANSITIONS

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR § 1.181**  
**TO WITHDRAW FINALITY OF OFFICE ACTION**

<b>CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. §1.8 (1)(B))</b>	
I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office at 703-872-9306 on the date shown below.	
Kathleen L. Boekley	
Type or print name of person signing certification	
	
Signature	Date

Dear Sir:

Applicants hereby petition the Commissioner for withdrawal of the finality of the Office Action mailed January 28, 2004. The facts are as follows.

In the non-final Office Action mailed August 12, 2003, the Examiner stated, in the Response to Arguments section on pages 5-6, that he was interpreting the claims as product-by-process regarding heat-shrinking techniques used to make a catheter. The Examiner stated that his interpretation of the claims was according to MPEP rules and case law. While the Examiner did provide case law citations in support of his assertion, he did not provide any specific MPEP rules.

On pages 2-3 of the response filed November 12, 2003, Applicants provided arguments regarding why the "shapable length" is a structural feature of the product and not a process by

Appl. No. 09/839,065

Petition dated April 27, 2004

Reply to Final Office Action of January 28, 2004

which the product is made. In particular, Applicants made arguments regarding the claimed structure of the product after it is manufactured.

In the Final Office Action mailed January 28, 2004, in the paragraph bridging pages 5-6, the Examiner responds to Applicants' arguments merely by repeating the assertion that the limitation "shapable by thermoforming techniques" is being interpreted as a method of manufacturing the claimed catheter "under the rules of MPEP and the cited case law." The Examiner again fails to provide any specific MPEP rules or other reasoning indicating why the phrase "shapable by thermoforming techniques" should cause a product claim to be transformed into a product-by-process claim. The same case law is cited, but is directed to the examination of claims actually reciting "the product of the process of Claim 1" (*Thorpe*) or to new uses for old products, and does not provide any indication of why or how a claim written as a product would be interpreted as product-by-process.

The Examiner then makes the statement that he "still believes that the catheter of Sampson will perform the same function of the applicant's claimed invention", however, this is the first time the Examiner has set forth this belief. Additionally, in neither the first action nor the current final action has the Examiner presented reasons why the structure of the Samson et al. catheter would be interpreted as having the same structure as the claimed product.

Without an explanation of why and under which rule the Examiner is interpreting the claims as product-by-process, Applicants cannot properly formulate arguments for Appeal. Applicants submit that in response to their arguments detailing why the phrase "shapable by thermoforming techniques" provides a structural limitation to the claimed product that is not found in the prior art, they are entitled to an explanation of the Examiner's reasoning for his continued interpretation of the claims as product-by-process in the face of claims clearly written as products.

In drafting arguments for Appeal, Applicants are left with responding to the Examiner's statement, without further explanation, that the claims are being interpreted as product-by-process claims. Applicants submit that the Office Action mailed January 28, 2004 does not contain a full and complete response to Applicant's previous arguments and therefore was improperly made final.

Appl. No. 09/839,065  
Petition dated April 27, 2004  
Reply to Final Office Action of January 28, 2004

In telephone interviews with the Examiner on March 18, 2004, and with the Examiner's supervisor, Brian Casler, on March 23, 2004, the finality of the January 29, 2004 Office Action was discussed. Applicants' representative was told that, in response to an After Final request for reconsideration, the Examiner would provide a further response to the arguments on record. Applicants submit that they were entitled to a full and complete response to the arguments presented in response to the non-final action of August 12, 2004, and that such communication should not be postponed until after a final action has been issued.

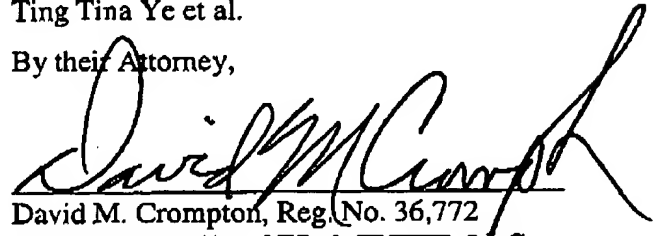
Applicants submit that a final action that merely repeats rejections presented in the first action and repeats assertions without providing any reasoning or explanation is not a proper final action. For the reasons set forth above, Applicants respectfully request the finality of the Office Action be withdrawn and a new non-final Office Action be issued.

If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Ting Tina Ye et al.

By their Attorney,



David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: \_\_\_\_\_

4/27/04